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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,526	10/06/2003	Kenji Kurisu	Furuta Case 39	3970

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EXAMINER

ZEMEL, IRINA SOPJIA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 10/679,526	Applicant(s) KURISU ET AL.	
	Examiner Irina S. Zemel	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 18, 19 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by GB Patent 1 477 825 to BASF (hereinafter "BASF"), or US Patent 4,384,049 to Rametsteiner (hereinafter "Rametsteiner"), or US Patent 3, 819,543 to Stasny et al., (hereinafter "Statsny"), or JP 06-007220 to Shinetsu Polymer CO, (hereinafter "Shinetsu").

Each of the cited reference discloses a method for processing a rubber composition to prepare a cellular rubber material comprising (A) 100 parts by mass of polymer which contains 30 to 100 % by mass of chlorinated polyethylene (CPE) with chlorine content corresponding to the chlorine content as per claim 3, (B) 1 to 30 parts by mass of organic blowing agent, and (C) 0.1 to 10 parts by mass of organic peroxide. See example 3 of BASF, example in column 4 of Stasny, abstract of Shinetsu and illustrative examples of Rametsteiner. While some methods are identical to the claimed method (extrusion-molding as disclosed in Stastny or Rametsteiner) or a different method, the process claims 18-19 and 22 are witted in a Japson-type format with the method steps being recited in the preamble. Any preamble limitation in a Japson claim is considered to be an admitted prior art. Thus, the only improvement of the claimed method lies in use of the certain claimed composition. As discussed above, each of the references expressly discloses the claimed composition, thus anticipating the claimed

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improvement. The limitations of claims 19 and 22 are also directed to the preamble, or the admitted prior art, thus not further patentably distinguishing the claimed invention over the admitted prior art.

The invention as claimed, therefore, is fully anticipated by each of the above cited references.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 16-17 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over BASF (hereinafter "BASF"), or US Patent 4,384,049 to Rametsteiner (hereinafter "Rametsteiner"), or US Patent 3, 819,543 to Stasny et al., (hereinafter "Statsny"), or JP 06-007220 to Shinetsu Polymer CO, (hereinafter "Shinetsu") alone or in combination with US Patent 5,041,329 to Tojo et al (hereinafter "Tojo").

As discussed in the previous office action, each of the references Each of the cited reference discloses a cellular rubber material comprising (A) 100 parts by mass of polymer which contains 30 to 100 % by mass of chlorinated polyethylene (CPE) with chlorine content corresponding to the chlorine content as per claim 3, (B) 1 to 30 parts by mass of organic blowing agent, and (C) 0.1 to 10 parts by mass of organic peroxide. See example 3 of BASF, example in column 4 of Stasny, abstract of Shinetsu and illustrative examples of Rametsteiner. Each of the references further discloses the

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decomposition temperature of the blowing agent which fully correspond the claims temperature. Shinetwu reference further expressly discloses one-minute-half life temperature T2 of the organic peroxide (C) that fully correspond to the claimed temperature. See [009]. The reference does not address a relationship between the decomposition temperature T1 of organic blowing agent (B) and the one-minute-half life temperature Tz of organic peroxide (C), however the references expressly disclose specific organic blowing agents (B) and organic peroxides (C) that are identical to the materials listed and used by the applicants in the instant application. Therefore, the claimed temperatures and temperature relationships are inherently met by the materials disclosed in the references.

The references do not expressly disclose the Mooney viscosity of the suitable chlorinated polypropylenes thus implying that CPE of any Mooney viscosity (M) are suitable for the disclosed inventions absent showing of unexpected results that can be attributed to the claimed M characteristic of the CPE. CPE with M characteristic corresponding to the claimed CPE is well known in the art and used for various thermoplastic compositions, including compositions for cellular material, as evidenced by Tojo, column 5, lines 49-62. Thus, as discussed above, use of CPE that exhibit the claimed M parameter would have been obvious absent showing of unexpected results that can be attributed to the claimed M characteristic of the CPE.

Further, Stastny or Rametsteiner references further disclose cellular rubber material prepared by extrusion-molding into a predetermined shape (granules or ribbon), heating, crosslinking and foaming a rubber composition comprising (A) 100

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parts by mass of polymer which contains 30 to 100 % by mass of polar group-substituted polymer, (B) 1 to 30 parts by mass of organic blowing agent, and (C) 0.1 to 10 parts by mass of organic peroxide.

BASF and Shinetsu discloses a process for producing of the materials disclosed in the references does not involve the extrusion step or the step of microwave heating. However, claims 17 and 21 are directed to the product (obtained by a specified process) and not the process. As such, the claims are met by any product obtained by any method so long as the product disclosed in the references is identical to the claimed product. In the instant case, it is believed that the product disclosed in both reference is identical to the claimed product since shaping by a method different from extrusion and heating by means different from microwave energy will result in the product with same characteristics. The burden was shifted to applicants to provide factual evidence to the contrary.

The claimed limitation to "a cosmetic sponge puff" does not define any structural limitation of a foam, and, thus, is met by the foamed products disclosed in any of the four primary references. Further, as per claim 22, which is directed to the preamble of a Japson claim 18, a cosmetic sponge puss is an admitted and known prior art.

The invention as claimed, is still considered to have been obvious from the combined teachings of any of the primary references with the secondary references.

### ***Response to Arguments***

Applicant's arguments filed 8-18-2005 have been fully considered but they are not persuasive. The applicants main argument is that the primary references do not

disclose some of the claimed characteristics, and, thus, the claimed invention is patentable over the disclosure of the cited references. The applicants state, for example, that BASF reference "has no discussion with respect to the Mooney viscosity of the chlorinated polyethylene and the one minute-half life temperature of the organic peroxide cross-linking agent. As such, it is respectfully submitted that the presently claimed invention is patentably distinguishable over this reference. "

The examiner strongly disagree with the applicants conclusion. While, indeed, the BASF reference does not expressly addresses some of the characteristics of the claimed components, this does not mean that the claimed characteristics are either not inherently exhibited by the materials disclosed in the reference and/or are obvious from the reference. For example, the examiner expressly addressed that while the reference is silent with regard to some individual characteristics of components B and C and their relationship, since references expressly disclose specific organic blowing agents (B) and organic peroxides (C) that are identical to the materials listed and used by the applicants in the instant application, the characteristics of the disclosed materials would be inherently identical to those characteristics claimed by applicants. Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The applicants provided no evidence that the disclosed compounds do Not inherently exhibit the claimed properties.

As far as the claimed Mooney viscosity of the chlorinated polyethylene component A, the examiner expressly addressed obviousness of use of chlorinated polyethylene with the claimed the Mooney viscosity in the absence of express disclosure of this characteristic in the primary references using the teachings of the secondary reference, Tojo. The applicants further argued that the showing of unexpected improvements rebuts the prima facie obviousness of the claimed invention over the prior art. The examiner can not find in the referenced tables ANY comparative results that address the claimed Mooney viscosity of the chlorinated polyethylene and improvements that can be attributed to this claimed characteristic.

With respect to the Rametsteiner reference the applicants argue that the presently claimed invention is distinguishable over this reference in that the Rametsteiner reference requires that the chlorinated polyethylene have a chlorine content containing chlorine in an amount of from 35 to 45% by weight, preferably at least 36% by weight, and this reference has no disclosure with respect to the Mooney viscosity of the chlorinated polyethylene resin, the decomposition temperature of the organic blowing agent, the one minute-half life temperature of the organic peroxide and the claimed relationship between the decomposition temperature of the organic blowing agent and the one minute-half life temperature of the organic peroxide blowing agent. "

With respect of the characteristics not expressly disclosed for components B and C, the same rationale of inherency as discussed above for the BASF reference applies to the Rametsteiner reference, since, again, the reference disclosed chemical compounds identical to those disclosed in the instant application. The same response



applies to the applicants arguments that the other two references, namely Stasny and Shinetsu do not address some of the characteristics of components B and C. So long as the references disclose identical chemical compounds, the limitations to their physical characteristics are inherently met.

As far as the claimed limitation to the chlorine content in the Rametsteiner reference, the expressly disclosed 35% as admitted by the applicants clearly anticipated the claimed range that also includes 35%.

And with respect to the Mooney viscosity of the chlorinated polyethylene component A, the examiner already discussed similar arguments why the claimed limitation would have been obvious in view of the secondary reference, Tojo, as for BASF reference. This response is equally applicable to arguments regarding Rametsteiner reference or Shinetsu reference.

As far as the differences in the processes disclosed in the BASF and the Shinetsu references, the examiner previously addressed this point and stated that the claims are directed to the product (obtained by a specified process) and not the process and, as such, the claims are met by any product obtained by any method so long as the product disclosed in the references is identical to the claimed product. The burden is shifted to applicants to provide factual evidence that the disclosed products obtained by a different method are materially different from the claimed products. However, no such evidence were provided.

Arguments regarding Tojo reference are directed to the compositions taught in that reference, however, Tojo reference was relied upon ONLY for showing that the

claimed component A is a commonly known and commercially available component, not that the compositions of Tojo anticipate the claimed invention. Thus, applicants arguments regarding Tojo reference appear to be irrelevant to the rejection made over the combined disclosure of any of the primary references in combination with Tojo and Not Tojo alone.

As far as alleged showing of unexpected results, no unexpected results that can be attributed to any of the claimed characteristics argued by the applicants are found in the specification. The comparative experiments use different resin A all together, and not component A with Mooney viscosity outside of the claimed range or any other claimed characteristics. Thus, the alleged showing of unexpected results, at least are NOT probative as compared to the closest prior art.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Irina S. Zemel  
Examiner  
Art Unit 1711



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